

REMARKS/ARGUMENTS

Formal Matters

Claims 26-27, 29 and 31-37 are pending.

Claims 26-27, 29 and 31-37 were examined and rejected.

Applicants respectfully request reconsideration of the application in view of the remarks made herein.

Rejection of claims under 35 U.S.C. § 112, first paragraph

Claims 26-27, 29 and 31-37 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which is not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Applicants respectfully traverse this rejection.

The claims are directed to methods for identifying an intracellular target molecule. As previously argued, the intracellular target molecule may be identified using, for example, routine methodologies once a bioactive peptide is identified. Once a bioactive peptide is identified, it may be used in a wide variety of routine screening binding assays to identify the intracellular target molecule to which it binds.

The Office argues that an intracellular target molecule can only be identified if a bioactive agent is first identified. That said, the Office reasons that the claims do not provide a bioactive peptide, and, as such, it would not be possible to identify an intracellular target molecule in the claimed method. The foundation of this rejection is the idea that the claims do not identify a bioactive peptide.

Contrary to the Office's arguments, however, the claimed methods *do* require that a bioactive peptide is identified. For example, each of claims 26 and 29 (the only independent claims) recite the phrase "to identify a cell that has an altered phenotype **and thereby identify a randomized peptide**" (emphasis added). Contrary to what the Office argues, the claims do require that an identified bioactive peptide. The claims require that the bioactive peptide *is* identified prior to identifying the intracellular target molecule that binds to the bioactive peptide.

In view of the above, the Applicants submit that the Office's position is not supported. As a point of fact, the claims *do* recite that a bioactive peptide is identified, and, as previously discussed, that bioactive peptide is readily employed to identify an intracellular target molecule.

The Examiner is reminded that the claims are direct to methods. The claims are *not* directed to a composition of the randomized peptide or intracellular target molecule. In essence, elements a) and b) of

USSN: 09/919,635

each of the independent claims recite steps in which a phenotype altering-peptide, i.e., a bioactive peptide, is identified, and element c) recites a step in which the intracellular target that binds to that peptide is identified. Each of these steps is well within the skill level of one of ordinary skill in the art, and, accordingly, the rejected claims may be practiced without undue experimentation.

The Applicants respectfully submit that this rejection has been fully addressed and may be withdrawn.

Double patenting

Claims 26-27, 29 and 31-37 are provisionally rejected over claims 1 and 4 of co-pending US Patent application 09/918,601.

Since 09/918,601 is abandoned, this rejection is moot.

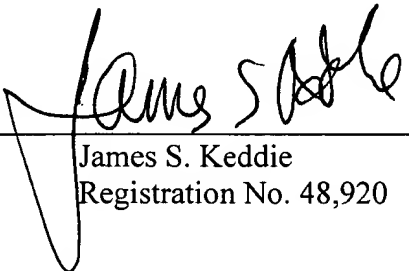
Withdrawal of this rejection is respectfully requested.

USSN: 09/919,635

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number RIGL-004CON4.

Respectfully submitted,
BOZICEVIC, FIELD & FRANCIS LLP

Date: 03/29/05

By: 
James S. Keddie
Registration No. 48,920

BOZICEVIC, FIELD & FRANCIS LLP
1900 University Avenue, Suite 200
East Palo Alto, CA 94303
Telephone: (650) 327-3400
Facsimile: (650) 327-3231

F:\DOCUMENT\RIGL (Rigel)\004CON4\response to 02-08-05 oa.doc